

Remarks

1. Summary of the office action

In the office action mailed September 9, 2010, (i) the Examiner rejected claims 1, 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0037068 (Thomas) in view of U.S. Patent No. 7,017,173 (Armstrong), (ii) the Examiner rejected claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Armstrong and U.S. Patent No. 7,225,142 (Apte), and (iii) the Examiner rejected claims 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Thomas in view of Armstrong and U.S. Patent No. 6,332,127 (Bandera).

2. Claim amendments and status of the claims

Applicant has amended claims 1, 5-11, 13-15, 17, 18, and 29, and added new claim 31. Claims 1, 2, 5-11, 13-15, 17, 18, and 22-31 are pending. Of the pending claims, claims 1 and 29 are independent.

3. Priority documents

The Examiner noted that Thomas claims domestic priority, under 35 U.S.C. § 119(e), to Provisional Application No. 60/193,894 (hereinafter Thomas-Provisional), filed on March 31, 2000. The current application (i.e., U.S. Patent Application No. 09/978,170) claims priority to U.S. Patent Application Nos. 60/240,714 and 60/240,715. U.S. Patent Application Nos. 60/240,714 and 60/240,715 were filed on October 15, 2000, which is after the March 31, 2000 filing date of Thomas-Provisional but prior to the March 30, 2001 filing date of Thomas.

Thomas includes subject matter that was not disclosed in Thomas-Provisional. Applicant submits that the subject matter of Thomas that was not disclosed in Thomas-Provisional is not prior art to U.S. Patent Application Nos. 60/240,714 and 60/240,715 or to the claims of the

current application that are supported by U.S. Patent Application Nos. 60/240,714 and/or 60/240,715.

Support for independent claim 1 is located in U.S. Patent Application No. 60/240,714, for example, at (i) page 5, last paragraph, lines 1-3, (ii) page 6, first paragraph, lines 1-4, (iii) page 7, lines 4-5, (iv) page 8, last paragraph, lines 2 and 6-10, (v) page 9, lines 3-4 and 17-18, (vi) page 10, lines 18-19, (vii) page 23, (viii) page 24, first paragraph and last paragraph, lines 1-3, and (ix) Figure 1(a). Since claim 1 is supported by U.S. Patent Application No. 60/240,714 and since Thomas is not prior art to U.S. Patent Application No. 60/240,714, Applicant submits that Thomas is not prior art to claim 1.

Support for independent claim 29 is located in U.S. Patent Application No. 60/240,714, for example, at (i) page 5, last paragraph, lines 1-3, (ii) page 6, first paragraph, lines 1-4, (iii) page 7, lines 4-5 and 23-24, (iv) page 8, last paragraph, lines 2 and 6-10, (v) page 9, lines 3-4 and 17-18, (vi) page 10, lines 18-19, (vii) page 23, (viii) page 24, first paragraph and last paragraph, lines 1-3, and (ix) Figure 1(a). Since claim 29 is supported by U.S. Patent Application No. 60/240,714 and since Thomas is not prior art to U.S. Patent Application No. 60/240,714, Applicant submits that Thomas is not prior art to claim 29.

4. Response to the claim rejections

a. Claims 1, 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, 29, and 30

The Examiner rejected claims 1, 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, 29, and 30 under 35 U.S.C. § 103(a) as being unpatentable over Thomas and Armstrong. Of those claims, claims 1 and 29 are independent. As stated above, Thomas is not prior art to claims 1 and 29. Therefore, Applicant addresses the rejections of claims 1 and 29 with respect to Thomas-Provisional and Armstrong instead of Thomas and Armstrong.

First, claims 1 and 29, as amended, each recite, *inter alia*, upon entering the pause mode, the video replay system starting a timer and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed. Applicant submits that Thomas-Provisional and Armstrong do not disclose or suggest a timer and Thomas-Provisional and Armstrong, therefore, do not reasonably or logically lead to the foregoing limitation recited in claims 1 and 29.

In rejecting claims 1 and 29, the Examiner stated that Armstrong discloses a *delay following the user's pressing the pause or stop button*, during which time the subscriber equipment displays selected user program content as still imagery (Armstrong C3, L35-41). See, office action, pages 3, 4, and 10. Without conceding the Examiner's remarks regarding that portion of Armstrong, Applicant submits that that portion of Armstrong does not reasonably or logically lead to, upon entering the pause mode, *the video replay system starting a timer and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed*, as recited in claims 1 and 29.

Armstrong, however, does disclose multiple steps carried out by the information provider equipment depicted in FIG. 2 of Armstrong. Those steps include (i) a step 0 in which the user causes a "pause" command to be sent to the set top box 260, for example, by pressing a "pause" key on a remote control device, (ii) a step 1 in which the set top box 260 receives the pause command and responsively causes the present video frame to be frozen, (iii) a step in which the set top box 260 propagates the pause command to the transport processor 240 via the communications network, (iv) a step 3 in which the transport processor 240 propagates the pause command to the head end controller 220, (v) a step 4 in which the head end controller propagates the pause command to the video server 230, (vi) a step 10 in which the transport processor 240 sends the display information to the set top box 260, and (vii) a step 11 in which the set top box

260 causes the ad information to be displayed by the presentation device 250. *See*, Armstrong, column 7, lines 40-66.

Even if, for the sake of argument, it is assumed that the foregoing steps disclose a delay between step 0 (pressing a pause key) and step 11 (when the ad information is displayed), Applicant submits that those steps, alone or in combination with the other steps disclosed by Armstrong, the other portions of Armstrong, and Thomas-Provisional, do not reasonably or logically lead to upon entering the pause mode, the video replay system starting a timer and subsequently using the timer to determine whether a time delay greater than zero seconds has elapsed, as recited in claims 1 and 29.

Next, since Thomas-Provisional and Armstrong do not disclose or suggest a timer, Applicant submits that Thomas-Provisional and Armstrong do not reasonably or logically lead to, *after starting the timer but prior to the video replay system determining that the time delay has elapsed*, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, and *after the video replay system determines that the time delay has elapsed*, displaying, on the display of the video replay system, the ad instead of the user selected program content, as recited in claim 1. Claim 29, as amended, recites similar limitations except that the words “user selected program content” in the foregoing limitations are listed as “video stream.” Applicant submits that Thomas-Provisional and Armstrong do not reasonably or logically lead to those limitations of claim 29 either.

Since Thomas is not prior art to claims 1 and 29 and since Thomas-Provisional and Armstrong do not reasonably or logically lead to each and every limitation recited in claims 1 and 29, Applicant submits that claims 1 and 29 are not obvious over Thomas, Thomas-Provisional

and Armstrong. Accordingly, Applicant submits that claims 1 and 29 are allowable. Furthermore, without conceding the Examiner's remarks regarding dependent claims 2, 5-11, 13-15, 17, 18, 22, 24, 26, 27, 29, and 30, Applicant submits that those claims are allowable for at least the reason that each of those claims depends from one of allowable independent claims 1 and 29.

b. Claim 23

The Examiner rejected dependent claim 23 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, Armstrong, and Apte. According to 35 U.S.C. § 112, fourth paragraph, a claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers. Since claim 23 refers claim 1, Applicant submits that claim 23 is to be construed to incorporate by reference all the limitations of claim 1.

As stated above, Thomas-Provisional and Armstrong do not reasonably or logically lead to, *after starting the timer but prior to the video replay system determining that the time delay has elapsed*, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, and *after the video replay system determines that the time delay has elapsed*, displaying, on the display of the video replay system, the ad instead of the user selected program content, as recited in claim 1. Applicant submits that Apte fails to make up for those deficiencies of Thomas-Provisional and Armstrong.

Since Thomas is not prior art with respect to claim 1, since Thomas-Provisional, Armstrong, and Apte do not reasonably or logically lead to each and every limitation recited in claim 1, and since claim 23 is to be construed to incorporate by reference each and every limitation of claim 1, without conceding the Examiner's assertions regarding claim 23, Applicant

submits that claim 23 is not obvious over Thomas, Armstrong, and Apte. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of claim 23.

c. Claims 25 and 28

The Examiner rejected dependent claims 25 and 28 under 35 U.S.C. § 103(a) as being unpatentable over Thomas, Armstrong and Bandera. Since claims 25 and 28 refer to claim 1, Applicant submits that pursuant to 35 U.S.C. § 112, fourth paragraph, claims 25 and 28 are to be construed to incorporate by reference all the limitations of claim 1.

As stated above, Thomas-Provisional and Armstrong do not reasonably or logically lead to, *after starting the timer but prior to the video replay system determining that the time delay has elapsed*, continuing to display the user selected program content on the display of the video replay system, wherein the user selected program content displayed during the time delay is paused, and *after the video replay system determines that the time delay has elapsed*, displaying, on the display of the video replay system, the ad instead of the user selected program content, as recited in claim 1. Applicant submits that Bandera fails to make up for those deficiencies of Thomas-Provisional and Armstrong.

Since Thomas is not prior art with respect to claim 1, since Thomas-Provisional, Armstrong, and Bandera do not reasonably or logically lead to each and every limitation recited in claim 1, and since claims 25 and 28 are to be construed to incorporate by reference each and every limitation of claim 1, without conceding the Examiner's assertions regarding claims 25 and 28, Applicant submits that claims 25 and 28 are not obvious over Thomas, Armstrong, and Bandera. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejections of claims 25 and 28.

5. New claim

Applicant has added new dependent claim 31. Applicant submits that claim 31 is allowable for at least the reason that it depends from allowable claim 1.

6. Conclusion

Applicant believes that all of the pending claims have been addressed in this response. For the foregoing reasons, Applicant submits that claims 1-2, 5-11, 13-15, 17, 18, and 22-31 are in condition for allowance. Therefore, Applicant respectfully requests favorable reconsideration and allowance of all the pending claims.

Respectfully submitted,

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